

REMARKS/ARGUMENTS

Claims 1, 7, 10, 13, 23, and 34 have been amended. Claim 2 has been cancelled. New claims 41-52 have been added. Support for the amendments and new claims can be found throughout the specification, including at page 5, lines 7-11 and 20-24; page 14, lines 16-26; and in the original claims. No new matter is added by the amendments. Claims 1 and 3-52 are pending in the application after entry of the amendments. Entry of the Amendment and reconsideration of the claims in view of the following Remarks is requested.

35 U.S.C. § 102

Claims 1, 11-13, 21-22, and 34 were rejected under 35 U.S.C. § 102(b) as anticipated by Domb et al. The Applicants traverse this rejection.

As an initial matter, Applicants note that "[a] claim is anticipated only if each and every element as set forth in the claims is found, expressly or inherently described, in a single prior art reference." *MPEP 2131* (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The amended claims recite a solution, suspension, or gel comprising a hydrophobic solvent, a hydrophilic solvent, a bioerodible polymer, and a beneficial agent. Applicants submit that Domb et al. discloses an emulsion, but does not disclose a solution, suspension, or gel as claimed.

Domb et al. is directed to nanoparticles and microparticles of nonlinear hydrophilic-hydrophobic multiblock polymers. This reference does not disclose or suggest that the microparticles or nanoparticles are formed into a solution, suspension, or gel comprising a hydrophobic solvent, a hydrophilic solvent, a bioerodible polymer, and a beneficial agent.

Rather, Domb et al. discloses injectable particles formed from a multiblock polymer mixture that is dissolved in water and organic solvents to form an emulsion (column 7, lines 55-57). The emulsion generates a phase-separated structure, resulting in formation of injectable particles upon evaporation of the organic solvent (column 7, lines 33-44 and 57-64). An emulsion comprises more than one liquid phase, and therefore is not a solution, suspension, or gel as defined by the specification (page 5, lines 23-24). As a result, Domb et al. does not disclose forming the presently claimed compositions that comprise a solution, suspension or gel rather than an emulsion, nor does it suggest any advantage in doing so. Consequently, claims 1,

11-13, 21-22, and 34 are patentable over Domb et al. Withdrawal of the rejection is respectfully requested.

Claim Objections

Claims 2-10, 14-20, 25-33 and 35-40 were objected to as depending from a rejected base claim. For the reasons discussed above, all base claims are in condition for allowance. Therefore, the dependent claims are also in condition for allowance. Withdrawal of the objection is respectfully requested.

Summary

Applicants submit that all pending claims are in condition for allowance, and notification to that effect is earnestly solicited. The Examiner is invited to contact Applicant's representative if prosecution may be assisted thereby.

Respectfully submitted,

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